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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,453	08/03/2001	Shridhar P. Joshi	47079-00064USP1	1760

30223 7590 07/15/2004

JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER

CAPRON, AARON J

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/922,453	JOSHI ET AL.	
	Examiner	Art Unit	
	Aaron J. Capron	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 17, 21, 24 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 17, 21, 24 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is a response to the Amendment received on April 23, 2004, in which claims 1, 17, 21 and 24 were amended, claims 27-32 were added, and claims 20, 22-23 and 25 were cancelled. Claims 1, 3-4, 17, 21, 24 and 27-32 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 17, 21, 24, 27-28 and 29-32 are rejected under 35 U.S.C. 102(e) as anticipated by Acres (U.S. Patent No. 6,254,483; hereafter “Acres”) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Acres in view of IGWB.

Acres discloses a gaming machine comprising monitoring a number of wager inputs from players of the gaming machine (6:44-50); and a processor for randomly selecting a plurality of outcomes in response to a wager inputs; a display for displaying the appearance for a wagering game; a memory device coupled to the processor and storing at least two data sets for producing two different appearances and sound effects for the gaming machine (abstract, 1:61-65 and 3:15-20), the processor automatically selecting one of the at least two data sets primarily in response to the processor monitoring a time signal corresponding to a predetermined number of wager inputs (abstract). It is inherent that all gambling games have a theme/artwork. Most casinos use

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equivalent gaming machines, but have different artwork to distinguish themselves from their competitors. In the alternative, where the interpretation of appearance does not include thematic game artwork, IGWB discloses the use of reconfiguring the theme of the game machine so that the winning symbols are changed from three sevens to cherries or cabooses (IGWB pages 11, 2-4 full paragraphs) in order to change the manner in which a player perceives the gaming machine. One would be motivated to combine the references in order to change the manner in which the player perceives the electronic gaming machine (Acres 3:15-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the themed artwork of IGWB into the gaming machine of Acres in order to change the manner in which a player perceives the gaming machine.

Referring to claims 3-4, Acres discloses the certain value is a predetermined value such that the step of altering occurs at any predetermined frequency (3:16-20 and 6:13-50).

Referring to claim 17, Acres discloses a method of operating a gaming machine, comprising storing a plurality of data sets for producing a plurality of different types of visual motifs on a display of the gaming machine (6:4-12); displaying a first visual motif on a display, discontinuing the first visual motif and displaying a second visual motif on the display based upon use of the gaming machine (abstract and 6:13-62).

Referring to claim 20, Acres discloses the step of displaying the second one occurs after a predetermined number of plays by the players (6:40-50)

Referring to claim 21, Acres discloses the step of displaying the second one occurs after determining a favorite visual motif of a variety of visual motifs to be displayed by monitoring inputs from the players (6:14-19).

Claims 24-25 correspond in scope to a gaming machine set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above.

Response to Arguments

Applicant's arguments filed April 23, 2004 have been fully considered but they are not persuasive.

Applicants assert that Acres's teaching on changing the appearance of gaming machine based upon time only limits the gaming machine to change the color(s) of the background. In addition, Applicants completely ignores the fact that Acres asserts changing the appearance of the gaming machine with respect to a predetermined time (abstract, 3:15-20) in order to change the manner in which the player perceives the gaming machine (3:15-16). The term "perceive" is defined as to achieve understanding of, apprehend (The American Heritage Dictionary of the English Language, Third Edition copyright 1992). In order to alter the appearance of the game machine in a manner in which the player perceives the game, without altering the game itself, the altering must involve the theme of the gaming machine. Changing the perception of the gaming machine would invoke a mental associated with a specific subject matter related to a theme. The changing of the appearance of the game can result in changing of multiple colors, background, symbols or elements. Therefore, the claimed invention fails to preclude the invention of Acres.

Applicants assert that Acres fails to disclose altering game symbols in a manner that is unassociated with a monetary value of wagers made during the plays of the gaming machine. However, Acres provides a series of variable that are monitored in order to determine whether to alter the configuration of the machine, wherein one of the variables being rate of play of the

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gaming machine (6:13-19). Rate of play is the number of plays over time. Due to the open-ended claim limitation, the claim is not so limiting as to exclude the use of rate of play, as disclosed by Acres; thus, the gaming machine monitors the number of plays at the gaming machine. In addition, if Applicants believe that the number of plays are still associated with monetary value, then Applicants must consider whether the present application comprises a monetary value associated with the number of plays at the gaming machine. Therefore, the claimed invention fails to preclude the invention of Acres.

Applicants assert that Acres in view of IGWB fail to disclose data sets corresponding to these symbols are stored in a single gaming machine or that a single gaming machine can alter the display after the predetermined parameter has been achieved. However, Acres discloses that the gaming machine can be in a stand-alone mode, hence without connection to the network (5:46-48) and, as stated above, the gaming alter the displayed elements after achieving a predetermined parameter (rate of play). Therefore, the claimed invention fails to preclude the invention of Acres in view of IGWB.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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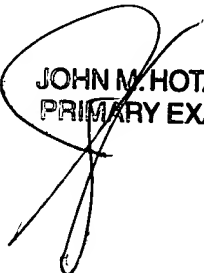
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc


JOHN M. HOTALING, II
PRIMARY EXAMINER